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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,769	01/22/2002	Manabu Ono	03310.024001	5557

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ROSENTHAL & OSHA L.L.P.
1221 MCKINNEY AVENUE
SUITE 2800
HOUSTON, TX 77010

EXAMINER

KEEHAN, CHRISTOPHER M

ART UNIT	PAPER NUMBER
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1712

3

DATE MAILED: 07/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/053,769

Applicant(s)

ONO ET AL.

Examiner

Christopher M. Keehan

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-7 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 7 recites the limitation "tackiness sheet" in claim 5. There is insufficient antecedent basis for this limitation in the claim. It is suggested to change the claim language from "wherein the tackiness sheet is shaped as a film-shape" to --wherein the adhesive sheet is shaped as a film--.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, and 5-7 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Okazaki et al. (6,503,961 B1). Regarding claim 1, Okazaki et al. disclose an adhesive composition comprising an imide (meth)acrylate (col.3, line 40-col.4, line 62), a homopolymerizable monomer

Art Unit: 1712

(col.2, lines 32-36 and col.5, lines 13-18) and a photoinitiator (col.7, lines 25-55), and the content of the imide (meth)acrylate is 1 to 20 parts by weight per 100 parts by weight of the homopolymerizable monomer (col.7, lines 4-23). Although Okazaki et al. do not appear to specifically disclose a glass transition temperature as claimed, it is inherently disclosed because the monomers are the same as disclosed by applicant, and the same monomers would have yielded the same glass transition temperature. If not inherent, then it would have been obvious to one of ordinary skill in the art for the monomers of Okazaki et al. to have an at least similar glass transition temperature, as the monomers of Okazaki et al. are at least similar to those of applicant, and at least similar monomers would have yielded a glass transition temperature with an at least similar glass transition temperature.

Regarding claim 2, Okazaki et al. disclose a formula that can yield the instantly claimed compound (col.4, lines 20-34).

Regarding claim 3, Okazaki et al. disclose 1 to 50 parts by weight of a compound per 100 parts by weight of the monomer, and wherein the compound is copolymerizable with the monomer (col.5, lines 10-50 and col.7, lines 3-7). It should be noted that the claim language "homopolymerizable" (as in this claim and claim 1) and "copolymerizable" (as in this claim) are being interpreted as "capable of being" homopolymerized and copolymerized. It is the examiner's position that the compounds of Okazaki et al. are capable of being homopolymerized and copolymerized, respectively.

Art Unit: 1712

Regarding claim 5, Okazaki et al. disclose an adhesive sheet (col.8, lines 30-38) of the composition as claimed (as set forth above for claim 1).

Regarding claims 6 and 7, Okazaki et al. disclose a base sheet and the adhesive layer formed on the base sheet as a film (col.8, lines 39-53).

Allowable Subject Matter

Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. A reasonable search of the prior art of record failed to reveal the limitations as set forth in claim 4, specifically a copolymerizable compound selected from the group as instantly claimed with an imide methacrylate, a homopolymerizable monomer, and a photoinitiator. JP 2000-05388 discloses an imide methacrylate, a copolymerizable compound selected from the group as instantly claimed, and a photoinitiator, but does not appear to teach or disclose a homopolymerizable compound with the glass transition temperature as claimed. Okazaki et al. disclose an imide methacrylate, a copolymerizable compound, and a photoinitiator, but do not appear to teach or disclose a copolymerizable compound selected from the group as instantly claimed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Keehan whose telephone number is

Art Unit: 1712

(703) 305-2778. The examiner can normally be reached on Monday-Friday, from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Dawson can be reached on 308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Christopher Keehan *ckm*

June 24, 2003



Robert Dawson
Supervisory Patent Examiner
Technology Center 1700